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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/732,715	12/10/2003	Kevin M. Lewandowski	59408US002	2046

32692	7590	07/13/2007
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EXAMINER	
SILVERMAN, ERIC E	

ART UNIT	PAPER NUMBER
1615	

NOTIFICATION DATE	DELIVERY MODE
07/13/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/732,715	Applicant(s) LEWANDOWSKI ET AL.	
	Examiner Eric E. Silverman, PhD	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 21-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :4-11-07,11-30-06,8-10-06,6-15-06,8-22-05,6-20-05,2-17-05,6-28-04.

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DETAILED ACTION

Applicant is advised that the Examiner assigned to this Application has changed. The Examiner currently assigned to this Application is **Eric Silverman, PhD**, whose contact information can be found at the end of this action. Applicant is further advised that this Application is currently assigned to **Art Unit 1615**.

Election/Restrictions

Claims 21 – 45 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 4/24/2007.

Applicants' arguments with regard to the election of species are persuasive. The species election is **withdrawn**.

Claims 1 – 20 are treated on the merits in this action.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 – 20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 23 of U.S. Patent No. 7,074,839. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims overlap in that while instant first oligomer has pendent nucleophilic or electrophilic groups, copending oligomer has pendent photopolymerizable groups. Since photopolymerizable groups are typically either nucleophilic or electrophilic (for instance, 1,1,1 trichloro groups are electrophilic and peroxide groups are nucleophilic in basic media), copending claims recite a species of instant claims, thus rendering instant claims obvious in their entirety.

Claims 1 – 20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 34 of copending Application No. 10/792,238. Although the conflicting claims are not identical, they are not patentably distinct from each other because copending (poly(alkylene oxide) cross linking agent is merely a subgenus of instant second component oligomer. Copending cross-linkers must be polyfunctional, as required by instant second polyfunctional component, else they would not serve as cross-linkers.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Applicant is advised that should claim 4 be found allowable, claim 5 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). The difference between the claims is only that while claim 4 recites "average degree of polymerization", whereas claim 5 recites "degree of polymerization". However, the degree of polymerization of a polymer may only be referred to as an average, since synthetic polymers, even when prepared by "controlled" processes, are necessarily polydisperse. Thus there is no difference between these two claims. For evidence of Examiners' assertion, see the Odian reference cited on PTO 892.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4 – 6, 14 – 16, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4 recites "average degree of polymerization". However, there are several different "average degree of polymerizations", such as number average, weight average, viscosity average, z average, etc. It is not clear which of these is being

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referred to. For evidence of Examiners' assertion, see the Odian reference cited on IDS filed 11/30/2006.

Claim 5 recites "degree of polymerization". However, the degree of polymerization of a polymer may only be referred to as an average, since synthetic polymers, even when prepared by "controlled" processes, are necessarily polydisperse. Thus there is no difference between these two claims. For evidence of Examiners' assertion, see the Odian reference cited IDS filed 11/30/2006.

Claim 6 recites "residual content". It is not clear what is meant by "residual" as claimed.

Claims 14 and recite "derived from polar monomer" and "derived from hydrophobic monomer". It is not clear what the metes and bounds of units are "derived from" a polar or hydrophobic monomer is. Furthermore, since "polar" monomers may also be "hydrophobic" (for example, methyl methacrylate is polar, having a polar ester group, but is also hydrophobic), it is not clear if part c) and d) of the claim need be two separate monomers, or if one monomer could account for both of them. The term "polymerized monomer units derived from ethylenically-unsaturated monomer units" is also unclear, since it is not certain if the polymerized monomer units are the product of polymerization of ethylenically unsaturated monomers or if they are the products of materials derived therefrom, or if they are the product of post-polymerization derivatization.

Claim Rejections - 35 USC § 102

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 – 20 are rejected under 35 U.S.C. 102(a) and 102(e) as being anticipated by WO 03/086493, of record, and also as being anticipated by US 7,005,143.

The WO document is a CON of the '143 reference, and is understood to have the same disclosure. In this discussion, reference is made to the WO reference with the understanding that the '143 reference has the same teachings.

The WO reference teaches a gel material, made from a multifunctional poly(alkylene oxide) macromer having molecular weight corresponding to a degree of polymerization less than 300 (table 4, page 12). The PAO macromer can be a copolymer of PEG and poly propylene glycol (structure on page 4, page 10, lines 9 – 10), and is included in amounts commensurate with instant claims (page 4 – 5). The macromers have nucleophilic and electrophilic pendant groups, such as acrylamide (instant claim 15, structure 3 on page 30 of the reference), protected functional groups (instant claim 18, structure 5 on page 30), and hydroxyl groups and esters (instant claim 19, structure 5 on page 30). The multifunctional initiator may be difunctional (page 11), thus serving as component b) in instant claims. Note that the formula of such difunctional materials comprises PAO and has formulas commensurate with instant claims (see pages 5 – 7 and formula III on page 15). Also see claims 1, 5, 6, 8, 9, and 30, which reveal the compositions of instant claims as part of a wound dressing,

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medical article, etc. Note that the final product of the claims must have a higher molecular weight than that which would be allowed by instant claims 4 and 5, but the claims nonetheless read on the "syrup polymer mixture" used to make the article, wound dressing, etc., as in claim 49 of the WO reference. With regard to instant claim 17, requiring a "step-growth catalyst", see claim 52 of WO, which teaches applying thermal energy (heat). Heat is understood to promote chemical reactions, including step-growth reactions.

Conclusion


No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric E. Silverman, PhD whose telephone number is 571 272 5549. The examiner can normally be reached on Monday to Friday 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571 272 8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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